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18 ORACLE AMERICA, INC.

19 UNITED STATES DISTRICT COURT
20 NORTHERN DISTRICT OF CALIFORNIA
21 SAN FRANCISCO DIVISION

22 ORACLE AMERICA, INC.

Case No. CV 10-03561 WHA

23 Plaintiff,

**ORACLE'S COMMENTS
REGARDING THE COURT'S
PROPOSED JURY INSTRUCTIONS
(PHASE ONE)**

24 v.

25 GOOGLE INC.

Dept.: Courtroom 8, 19th Floor
Judge: Honorable William H. Alsup

26 Defendant.

1 At the Court's request, Oracle America, Inc. ("Oracle") discusses below the three issues
 2 of greatest concern regarding the Court's proposed jury instructions distributed on April 26, 2012.
 3 Oracle may raise additional items regarding the jury instructions and the Court's special verdict
 4 form at the charging conference on April 27, 2012.

5 **I. THE JURY SHOULD BE INSTRUCTED THAT THE STRUCTURE,
 6 SEQUENCE, AND ORGANIZATION OF THE 37 JAVA API PACKAGES
 AS EXPRESSED IN THE API DOCUMENTATION IS ALSO AT ISSUE**

7 Oracle objects to the Court's Instruction No. 21 that "For the API documentation issue,
 8 you do not need to be concerned with structure, sequence, and organization, a concept that applies
 9 only to the compilable code part of the case." (ECF No. 994 at 12-13.) The structure, sequence,
 10 and organization ("SSO") of the API packages exists within the API documentation as well and
 11 Google should be liable for copying it.¹ It would be error to instruct the jury to disregard it.

12 Dr. Reinhold, Chief Java Architect at Oracle, explained that the structure expressed in the
 13 API documentation is the same as the structure within the compilable code because the code is
 14 run through the Java Documentation Extractor (or "Javadoc") to pull out the structure and English
 15 language comments, and produce a webpage that reflects the same SSO of the API that is in the
 16 code. (RT at 606:14-608:3 (Reinhold); TX 1046 at p.19 of 24.)

17 Now, we also run that source file through another tool called the
 18 Java Documentation Extractor or JavaDoc for short. That tool
 19 processes this file. It pulls out the structure, the names. It ignores
 20 the actual instructions in the methods. It also pulls out the English
 21 prose, which is in comments in this file, and produces the web page
 22 that we have been looking at already.

23 ¹ The Court has acknowledged the importance of the structure, sequence, and organization
 24 expressed within the API documentation, explaining:

25 The specification for a class library—much like the specification for an
 26 automobile—is an item of detailed documentation that explains the
 27 organization and function of all packages, classes, methods, and data
 28 fields in the library. The class library specification for a given software
 platform, sometimes called the 'API Specification' is an important
 reference item for programmers."

(ECF No. 433 at 3.)

1 So in a very real sense this is software that contains its own
 2 blueprint. All right. An API is a blueprint, well, the blueprint is in
 3 the source file along with all of the instructions that actually wind
 up in the class library.

4 (Id.) In response to the Court's questions, Dr. Reinhold explained that, "In terms of the actual
 5 text, the words [in the documentation] are copied over, the API structure is copied over from the
 6 source file, and all of the words describing each method or field are also copied over." (RT at
 7 609:1-9.) (*See also* RT 1169:8-15 (Lee agreeing that like Java documentation, Android
 8 documentation was "created by a tool that actually reads portions of the source code and then
 9 places it in a kind of template that's available on the web as a source of documentation."))

10 Regardless of whether the SSO is expressed in the compilable code or the API
 11 documentation, it is protectable expression in both cases. In *Am. Dental Ass'n v. Delta Dental*
 12 *Plans Ass'n*, Judge Easterbrook found that the structure of dental code which organized various
 13 dental procedures into a hierarchy represented in three formats – numerically, by short
 14 description, and by long description – was equally protectable regardless of which format was
 15 copied. 126 F.3d 977, 979, 980-981 (7th Cir. 1997) ("The long description is part of the
 16 copyrighted work, and original long descriptions make the work as a whole copyrightable. But
 17 we think that even the short description and the number are original works of authorship."). The
 18 infringer copied "most of the numbering system and short descriptions from the ADA's Code,"
 19 and the Court did not distinguish one format from the other. It explained that taxonomies, such as
 20 the West Key Number System and the dental code, are not "systems" and are protectable as
 21 expression. 126 F.3d at 978 (7th Cir. 1997) (noting that "[b]lueprints for large buildings (more
 22 committee work), instruction manuals for repairing automobiles, used car value guides,
 23 dictionaries, encyclopedias, maps" are protectable original expression).² Analogously, if the SSO
 24 of the 37 Java API packages is protectable as expressed in source code, it is also protectable as

25 ² The court explained that "Facts do not supply their own principles of organization.
 26 Classification is a creative endeavor. Butterflies may be grouped by their color, or the shape of
 27 their wings, or their feeding or breeding habits, or their habitats, or the attributes of their
 caterpillars, or the sequence of their DNA; each scheme of classification could be expressed in
 multiple ways." *Id.* at 979.

1 expressed in the API documentation. Far less creative structures have been found subject to
 2 copyright protection in this Circuit. *See, e.g., CDN Inc. v. Kapes*, 197 F.3d 1256, 1262 (9th Cir.
 3 1999) (prices in guide for collectible coins); *Practice Mgmt. Info. Corp. v. Am. Med. Ass'n*,
 4 877 F. Supp. 1386, 1390-92 (C.D. Cal. 1994), *aff'd in relevant part*, 121 F.3d 516 (9th Cir. 1997)
 5 (numerical codes for medical procedures); *Jacobsen v. Katzer*, 2009 U.S. Dist. LEXIS 115204, at
 6 *9-10 (N.D. Cal. Dec. 10, 2009) (text files reflecting decoder information from model railroad
 7 manufacturers).

8 The trial evidence shows that Google copied the English language descriptions of API
 9 elements within the API documentation into Android. (*See* RT 1169-1176 (Lee comparing the
 10 wording between Java and Android documentation). But Oracle's claim should not be limited to
 11 that form of copying. Oracle is also entitled to submit to the jury that the SSO expressed within
 12 the API documentation was copied, in addition to the English language descriptions. (RT 1174:1-
 13 16 (Lee) ("Q. And the structure of the documentation is identical; correct, sir? And if you think of
 14 it as an outline, the outline would match identically; correct, sir? A. Yes. Q. And that's because
 15 on the Android side you're documenting the same application programming interfaces as were
 16 documented on the Java side; correct, sir? 16 A. Yes.".)

17 On a related point, in Instruction No. 25, Oracle disagrees that the jury should be
 18 instructed to apply the "virtually identical" standard to API documentation "because the
 19 documentation for the API packages describe narrow technical functions and it is to be expected
 20 that the same words and phrases would be more likely used." The structure, sequence, and
 21 organization of the documentation involves equally as many design choices as the
 22 implementation does. Copying the SSO from the API documentation should be subject to the
 23 same substantial similarity test used for copying the compilable code. *See Johnson Controls,*
 24 *Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173, 1176 (9th Cir. 1989) (applying substantial
 25 similarity standard to copied non-literal elements of computer software).

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1 **II. THE JURY SHOULD BE INSTRUCTED THAT THE NAMES OF JAVA
2 API PACKAGE ELEMENTS ARE PROTECTABLE AS PART OF THE
3 STRUCTURE, SEQUENCE, AND ORGANIZATION OF THOSE
4 PACKAGES**

5 The Court's Proposed Instruction No. 20 states that "copyrights do not cover the names
6 given to files or packages because under the law, names cannot be copyrighted." This sentence
7 tracks the Court's earlier ruling that individual names are not protectable by copyright. (See ECF
8 No. 433 at 7-8.) Instruction No. 20 does not, however, reflect the issue that the Court left open
9 regarding names – "the possibility that the selection or arrangement of those names is subject to
10 copyright protection." (*Id.* at 8.) As currently drafted, the instruction omits the concept that
11 names may be protectable *as part of* the SSO of the 37 Java API packages. Instruction No. 20
12 may be misinterpreted by the jury as a directive to disregard the names completely, which would
13 make it difficult or impossible to assess the SSO of the 37 API packages of which the names are
14 an integral part. To clarify this point, Oracle proposes adding at least one sentence to Instruction
15 No. 20: "While individual names are not protectable on a standalone basis, the names are
16 protectable as part of the structure, sequence, and organization of the 37 API packages."

17 The Court's prior ruling that names are not protectable was limited to individual names or
18 short phrases taken on a standalone basis. (ECF No. 433 at 7-8 (citing *Sega Enters. Ltd. v.
19 Accolade, Inc.*, 977 F.2d 1510, 1524 n.7 (9th Cir. 1992) ("Sega's security code is of such de
minimis length that it is probably unprotected under the words and short phrases doctrine")).)
20 The Court expressly acknowledged that "[c]opyright protection for the selection and arrangement
21 of elements within a work is a separate question from whether the elements themselves are
22 protected by copyright." (*Id.* (citing *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d
23 1140, 1147 (9th Cir. 2003) ("a combination of unprotectable elements is eligible for copyright
24 protection only if those elements are numerous enough and their selection and arrangement
25 original enough that their combination constitutes an original work of authorship")).) The law is
26 clear that elements that are unprotectable on an individual basis may be combined into a
27 protectable whole if their selection and arrangement is sufficiently original. *See Feist Publ'n's,
28 Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362 (1991) ("[t]he question that remains is whether

1 Rural selected, coordinated, or arranged these uncopyrightable facts in an original way. As
 2 mentioned, originality is not a stringent standard . . ."). *See also Merchant Transaction Sys. v.*
 3 *Nelcela, Inc.*, 2009 U.S. Dist. LEXIS 25663, at *49 (D. Ariz. 2009) ("the Court cannot conclude
 4 that no reasonable juror could not find creativity in the selection and arrangement of the Lexcel
 5 software's field names, let alone the remaining allegedly similar non-literal elements of the
 6 Lexcel software, sufficient to render the compilation original enough for protection.").

7 In this case, the SSO of the 37 API packages is manifested, in part, in a hierarchy of
 8 named packages, classes, methods, and other elements such as interfaces and fields. Dr.
 9 Reinhold, Chief Java Architect at Oracle, provided the following example showing the hierarchy
 10 of some of the classes in the "java.nio.channels" package:

11 **java.nio.channels**

12 **- Object**

- 13 **- Channels**
- 14 **- FileLock**
- 15 **- Pipe**
- 16 **- SelectionKey**
- 17 **- Selection**

18 **- AbstractInterruptibleChannel**

- 19 - FileChannel
- 20 - SelectableChannel
- 21 - AbstractSelectableChannel
- 22 - DatagramChannel
- 23 - ServerSocketChannel
- 24 - SocketChannel

25 (RT at 594:2-596:22 (Reinhold); TX 1046 at slide 9 (p.11 of 24).) To meaningfully evaluate the
 26 SSO of the API packages, the jury will need to consider the named elements as part of the
 27 structure. Without the named elements, the upper portions of the hierarchy (everything above the
 28 method declarations) would be incomprehensible:

29 **- Object**

- 30 - _____
- 31 - _____
- 32 - _____

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6 This cannot be the intended result of the Court's earlier ruling regarding names. The method
7 declarations themselves consist of words and short phrases that might not be copyrightable in
8 isolation (e.g., "public static int max (int arg1, int arg2)"), yet this does not mean that the
9 declarations are unprotectable. (RT at 786:1-787:8 (Bloch).)³ While the Court ruled that
10 individual names are unprotectable, names in the context of the SSO are part of what is
11 protectable. Instruction No. 20 should reflect that distinction, as suggested by Oracle's proposed
12 edits.

13 **III. THE JURY SHOULD BE GIVEN MORE GUIDANCE ON THE**
 14 **ELEMENTS OF GOOGLE'S FAIR USE DEFENSE**

15 The Court's Instruction No. 28 regarding Google's fair use defense should be
 16 supplemented to provide additional guidance to the jury on how each of the statutory factors is to
 17 be applied. Factors 1, 3, and 4 currently provide no indication as to whether those elements
 18 weigh for or against fair use, and factor 2 is ambiguous without further explanation. To provide
 19 clarity, Oracle proposes a few additions to this instruction:

20 First, to help orient the jury to the concept of "fair use," the instruction should include the
 21 following preamble language from Section 107:

22 [F]air use of a copyrighted work . . . for purposes such as criticism, comment, news
 23 reporting, teaching (including multiple copies for classroom use), scholarship, or
 research, is not an infringement of copyright.

24 17 U.S.C. § 107. This language provides useful examples of the types of activities that may
 25 constitute fair use of a copyrighted work.

26 ³ Dr. Bloch acknowledged that the selection of names for API elements is important. (RT
 27 at 744:16-745:20.)

1 Second, Oracle proposes the following additions to the fair use factors in Instruction
 2 No. 28, drawn from the caselaw cited in the Model Instructions (NINTH CIRCUIT MANUAL OF
 3 MODEL JURY INSTRUCTIONS – CIVIL No. 17.18 Comment (2007)):

4 **Factor 1:** Oracle proposes adding –“Commercial use weighs against a finding of fair
 5 use.” *See Elvis Presley Enters., Inc. v Passport Video*, 349 F.3d 622, 627 (9th Cir. 2003) (“the
 6 fact that a new use is commercial as opposed to non-profit weighs against a finding of fair use”).

7 **Factor 2:** Oracle proposes adding – “If the original copyrighted work is creative in
 8 nature, this cuts against a finding of fair use.” *See A&M Records, Inc. v. Napster, Inc.*, 239 F.3d
 9 1004, 1015 (9th Cir. 2001) (“[w]orks that are creative in nature are ‘closer to the core of intended
 10 copyright protection’ than are more fact-based works”).

11 **Factor 3:** Oracle proposes adding – “The greater the quantity and quality of the work
 12 taken, the less that fair use applies. Copying may not be excused merely because it is
 13 insubstantial with respect to the infringing work.” *See Elvis*, 349 F.3d at 630 (“[C]opying may
 14 not be excused merely because it is insubstantial with respect to the infringing work.”).

15 **Factor 4:** Oracle proposes adding – “When the defendant’s use of the copyrighted work
 16 competes with the copyrighted work, then it is less likely a fair use.” *Triad Sys. Corp. v. Se.
 17 Express Co.*, 64 F.3d 1330, 1337 (9th Cir. 1995) (defendant’s use of plaintiff’s software in
 18 providing a competing service was not a fair use).

19 In sum, Oracle’s neutral and accurate explanations will be helpful to the jury in analyzing
 20 the four factors.

21 Dated: April 26, 2012

MORRISON & FOERSTER LLP

22 By: /s/ Michael A. Jacobs

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 24 Attorneys for Plaintiff
 ORACLE AMERICA, INC.

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